

ESTTA Tracking number: **ESTTA537665**

Filing date: **05/14/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | | | |
|---------|--|-------------|--------------------|
| Name | PUMA SE | | |
| Entity | Corporation | Citizenship | European Community |
| Address | PUMA Way 1 Herzogenaurach, 91074 GERMANY | | |

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|----------------------|--|
| Attorney information | Lynn A. Sullivan Leydig Voit & Mayer, Ltd. Two Prudential Plaza, 180 N. Stetson, Suite 4900 Chicago, IL 60601 UNITED STATES lsullivan@leydig.com Phone:312-616-5652 |
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Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 85775772 | Publication date | 04/16/2013 |
| Opposition Filing Date | 05/14/2013 | Opposition Period Ends | 05/16/2013 |
| Applicant | GONZALEZ ESPEJEL, FRANCISCO ISIDRO Blvd. Gonzalez Bocanegra #2001 Colonia El Tlacuache LeÃ³n, Guanajuato, 37500 MEXICO | | |

Goods/Services Affected by Opposition

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| Class 025. All goods and services in the class are opposed, namely: Footwear; Shoes |
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Grounds for Opposition

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|--------------------------------------|-----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3369752 | Application Date | 02/02/2007 |
| Registration Date | 01/15/2008 | Foreign Priority Date | 09/30/2006 |
| Word Mark | NONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |

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|----------------|--|
| Goods/Services | <p>Class 018. First use:</p> <p>leather and imitations of leather sold in bulk; goods made of leather or of leather imitations, namely, drawstring pouches, duffel bags, backpacks, book bags, handbags, suitcases, carry-on bags, travelling bags, luggage grip bags; purses, pocket wallets, key cases, sports bags and sports pouches, duffel bags, rucksacks, school bags, hip bags, toilet bags sold empty; trunks and travelling cases; umbrellas, parasols and walking sticks</p> <p>Class 025. First use:</p> <p>clothing, namely, sports and leisure suits, training suits, warm-up suits, all-weather suits, pullovers, jerseys, jackets, sweatshirts, shorts, shirts, pants, t-shirts, tops, skirts, socks, wristbands, athletic uniforms, blousons, turtlenecks, camisoles, sweaters, cardigans, wraps, cover-ups, coats, dresses, blouses, underwear, tank tops, trousers, tights, bathing suits, neckerchiefs, scarves, belts; footwear; headgear, namely, namely berets, earmuffs, hats, caps, sun visors, toques, hoods, headbands</p> <p>Class 028. First use:</p> <p>games and playthings, namely, gymnastic apparatus; sporting apparatus and articles, namely, handgrips for gripping gymnastic equipment, pumps and ball needles for inflating sports balls, balls for games, namely, basketballs, soccer balls, footballs, volleyballs, handballs, baseballs, bowling balls, tennis balls, table tennis balls, golf balls; shinguards, knee, elbow and ankle pads for sports purposes; sporting gloves, namely, goalkeepers gloves, boxing gloves, baseball gloves, golf gloves, racket ball gloves, bicycling gloves and ski gloves; tennis rackets, cricket bats, golf clubs, hockey sticks, table tennis bats, badminton and squash rackets; bags for sporting articles adapted to the product they are intended to contain; adapted bags and coverings for tennis, badminton and squash rackets, for table tennis and cricket bats, for golf clubs and for hockey sticks; roller skates, ice skates and in-line skates, tables and nets for table tennis</p> |
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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 890009 | Application Date | 01/08/1968 |
| Registration Date | 04/28/1970 | Foreign Priority Date | NONE |
| Word Mark | NONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 025. First use: First Use: 1958/00/00 First Use In Commerce: 1958/00/00</p> <p>SPORT SHOES-NAMELY, SOCCER SHOES, [LACROSSE SHOES,] BOWLING SHOES, BOXING SHOES, [GYMNASTIC SHOES,] JOGGING SHOES, WRESTLING SHOES, FENCING SHOES, TRACK SHOES, CROSS COUNTRY SHOES; [AND FOOTBALL SHOES] SPORTING SHOES-NAMELY, BASKETBALL SHOES, TENNIS SHOES, AND BOATING SHOES</p> | | |

| | | | |
|-----------------------|-----------------------|-----------------------|------------|
| U.S. Registration No. | 1256945 | Application Date | 09/30/1980 |
| Registration Date | 11/08/1983 | Foreign Priority Date | NONE |
| Word Mark | NONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: | | |

| | |
|--|--|
| | Shoes, Especially Sports and Leisure Shoes |
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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1135790 | Application Date | 10/11/1977 |
| Registration Date | 05/20/1980 | Foreign Priority Date | NONE |
| Word Mark | NONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1958/00/00 First Use In Commerce: 1958/00/00 SHOES, PARTICULARLY SPORT AND LEISURE SHOES | | |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1135790 | Application Date | 10/11/1977 |
| Registration Date | 05/20/1980 | Foreign Priority Date | NONE |
| Word Mark | NONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1958/00/00 First Use In Commerce: 1958/00/00 SHOES, PARTICULARLY SPORT AND LEISURE SHOES | | |

| | |
|-------------|---|
| Attachments | Notice of Opposition.pdf(1085412 bytes) Exhibits A-E.pdf(924466 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|--------------------|
| Signature | /Lynn A. Sullivan/ |
| Name | Lynn A. Sullivan |
| Date | 05/14/2013 |



2. Opposer has used its Formstrip design in the United States and many other countries for its athletic shoes continuously and exclusively for 50 years. - Opposer has also used the Formstrip design on other products such as clothing, headwear, sport bags, sports wear and accessories. Accordingly, Opposer's Formstrip design has become well known not only in the United States but nearly worldwide.

3. Opposer is the owner of U. S. Trademark Registration No. 3369752, registered January 15, 2008, for its Formstrip design mark, as shown in Exhibit A attached hereto for goods which include, *inter alia*, "...footwear..." in International Class 25.

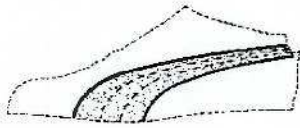


4. Opposer is the owner of U. S. Trademark Registration No. 890,009, registered April 28, 1970, for a Formstrip design mark comprised of a curved band or strip adapted to be placed on sport shoes, which runs from the upper heel portion of the footwear and curves down to the sole as shown in Exhibit B attached hereto, for goods which include, *inter alia*, Sport Shoes – namely, soccer shoes, bowling shoes, boxing shoes, jogging shoes, wrestling shoes, fencing shoes, track shoes, cross country shoes; sporting shoes - namely, basketball shoes, tennis shoes, and boating shoes, in International Class 25.



5. Opposer is the owner of U. S. Trademark Registration No. 1,256,945, registered November 8, 1983, for a Formstrip design mark comprised of a curved band or strip placed on shoes longitudinal subdivided into three subsections, that run from the upper heel portion of the footwear and curves as it reaches the sole, as shown in Exhibit C attached hereto for goods which include, *inter alia*, shoes, especially sports and leisure shoes, in International Class 25. The stippling shown

on this registration drawing is for the purpose of dividing the stitching part of the mark into three sections which has the appearance of 3 parallel bands, a design very similar to the appearance of applicant's 3 parallel bands that widen at the curve.



6. Opposer is the owner of U. S. Trademark Registration No. 1,135,790, registered May 20, 1980, for a Formstrip design mark comprised of a curved band or strip, as shown in Exhibit D attached hereto for goods which include, *inter alia*, "Shoes, particularly sport and leisure shoes" in International Class 25.



7. As noted in paragraph 2, since long prior to the November 9, 2012 filing date of the intent to use application which is the subject of this opposition, Opposer adopted and commenced use of its Formstrip as a trademark in connection with the marketing, promoting, offering for sale and selling of various items including footwear, headwear, sports bags, sportswear, clothing and accessories in the United States, continuously using combinations of coloring, texturing, and the like which give the Formstrip the appearance of a band or strip composed of more than one band running parallel to each other. Opposer's Formstrip has been continuously used by Opposer in connection with the marketing, promoting, offering for sale and selling of its products in the United States and virtually worldwide. See Exhibit E.

8. As a result of the extensive use and advertising by Opposer of the trademarks referred to in Paragraphs 3-6 hereof, said marks have become extremely well known as symbolic of Opposer and Opposer has built up valuable goodwill in said marks such that the marks have come to identify

Opposer's goods, especially footwear, and distinguish Opposer's goods, from the related goods of others.

9. The goods identified by Applicant in Serial No. 85/775772 are the same as the goods on which Opposer has previously used and now uses its Formstrip trademarks referred to above and to the goods recited in Opposer's registrations referred to in Paragraphs 3-6 hereof.

10. The mark of Serial No. 85/775772 (hereinafter "Applicant's Mark"), is likewise 3 parallel lines that curve at the bottom end. The mark is intended to be used on footwear and shoes.

11. Applicant's Mark is substantially similar and creates the same or substantially the same commercial impression in the minds of prospective purchasers as the trademarks referred to above and as previously used by Opposer and is likely when applied to the goods of the Applicant to cause confusion, or to cause mistake, or to deceive, all to Opposer's damage.



COUNT 2 – DILUTION

12. Opposer's Formstrip trademarks referred to above have had extensive national exposure for decades, being prominently apparent on clothing, particularly footwear, headwear, sports bags, sports wear and accessories sold to the general public and worn by numerous athletic stars, over the years. As a result of the extensive use and advertising of Opposer's marks and the publicity associated with their use by well known athletes for many years, Opposer's Formstrip marks have become famous. Registration and use by Applicant of Applicant's Mark will dilute the distinctive quality of Opposer's Formstrip marks, all to Opposer's damage.

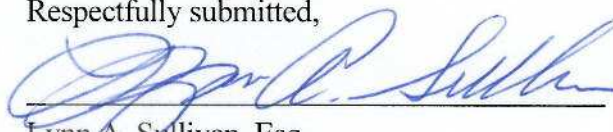
13. As a result of the extensive advertising, sales and national as well as worldwide exposure, the public has come to associate the Formstrip mark of the types shown in Exhibits A-E

attached to this Opposition in various forms, patterns and manners of coloration, with Opposer. Registration and use of the Applicant's Mark will affect Opposer's right to continue to freely use its Formstrip marks and will dilute the public's association of its Formstrip marks with Opposer.

WHEREFORE, Opposer prays that Application No. 85/775772 be rejected based on the fact that Applicant's Strip Design mark is confusingly similar to Opposer's Formstrip mark, and that it will dilute the distinctive quality of Opposer's mark, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

Date: April 14, 2013



Lynn A. Sullivan, Esq.
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Michelle L. Zimmermann, Esq.
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180 North Stetson Avenue
Chicago, IL 60601
Telephone: (312) 616-5600
Attorneys for Opposer
PUMA SE

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above document was filed electronically with the Trademark Trial & Appeal Board on April 14, 2013.



Lynn A. Sullivan, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of this document has been served by first-class mail to:

ARTURO PÉREZ-GUERRERO
LAW OFFICES OF ARTURO PÉREZ-GUERRERO
P.O. BOX 9024163
SAN JUAN, PUERTO RICO 00902-4163
UNITED STATES

Date: April 14, 2013

Signed: _____

Lynn A. Sullivan, Esq.



EXHIBIT A

Int. Cls.: 18, 25 and 28

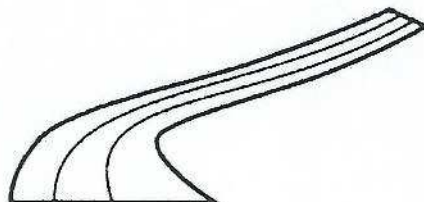
Prior U.S. Cls.: 1, 2, 3, 22, 23, 38, 39, 41 and 50

United States Patent and Trademark Office

Reg. No. 3,369,752

Registered Jan. 15, 2008

TRADEMARK
PRINCIPAL REGISTER



PUMA AKTIENGESELLSCHAFT; RUDOLF
DASSLER SPORT (FED REP GERMANY COR-
PORATION)
WÜRZBURGER STRASSE 13
91074 HERZOGENAURACH, FED REP GERMANY

FOR: LEATHER AND IMITATIONS OF LEA-
THER SOLD IN BULK; GOODS MADE OF LEA-
THER OR OF LEATHER IMITATIONS, NAMELY,
DRAWSTRING POUCHES, DUFFEL BAGS, BACK-
PACKS, BOOK BAGS, HANDBAGS, SUITCASES,
CARRY-ON BAGS, TRAVELLING BAGS, LUG-
GAGE GRIP BAGS; PURSES, POCKET WALLETS,
KEY CASES, SPORTS BAGS AND SPORTS POU-
CHES, DUFFEL BAGS, RUCKSACKS, SCHOOL
BAGS, HIP BAGS, TOILET BAGS SOLD EMPTY;
TRUNKS AND TRAVELLING CASES; UMBREL-
LAS, PARASOLS AND WALKING STICKS, IN
CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FOR: CLOTHING, NAMELY, SPORTS AND LEI-
SURE SUITS, TRAINING SUITS, WARM-UP SUITS,
ALL-WEATHER SUITS, PULLOVERS, JERSEYS,
JACKETS, SWEATSHIRTS, SHORTS, SHIRTS,
PANTS, T-SHIRTS, TOPS, SKIRTS, SOCKS, WRIST-
BANDS, ATHLETIC UNIFORMS, BLOUSONS, TUR-
TLENECKS, CAMISOLES, SWEATERS,
CARDIGANS, WRAPS, COVER-UPS, COATS, DRES-
SES, BLOUSES, UNDERWEAR, TANK TOPS, TROU-
SERS, TIGHTS, BATHING SUITS, NECKERCHIEFS,
SCARVES, BELTS; FOOTWEAR; HEADGEAR,
NAMELY, NAMELY BERETS, EARMUFFS, HATS,
CAPS, SUN VISORS, TOQUES, HOODS, HEAD-
BANDS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FOR: GAMES AND PLAYTHINGS, NAMELY,
GYMNASTIC APPARATUS; SPORTING APPARA-

TUS AND ARTICLES, NAMELY, HANDGRIPS FOR
GRIPPING GYMNASTIC EQUIPMENT, PUMPS
AND BALL NEEDLES FOR INFLATING SPORTS
BALLS, BALLS FOR GAMES, NAMELY, BASKET-
BALLS, SOCCER BALLS, FOOTBALLS, VOLLEY-
BALLS, HANDBALLS, BASEBALLS, BOWLING
BALLS, TENNIS BALLS, TABLE TENNIS BALLS,
GOLF BALLS; SHINGUARDS, KNEE, ELBOW AND
ANKLE PADS FOR SPORTS PURPOSES; SPORTING
GLOVES, NAMELY, GOALKEEPERS GLOVES,
BOXING GLOVES, BASEBALL GLOVES, GOLF
GLOVES, RACKET BALL GLOVES, BICYCLING
GLOVES AND SKI GLOVES; TENNIS RACKETS,
CRICKET BATS, GOLF CLUBS, HOCKEY STICKS,
TABLE TENNIS BATS, BADMINTON AND SQUASH
RACKETS; BAGS FOR SPORTING ARTICLES
ADAPTED TO THE PRODUCT THEY ARE INTEN-
DED TO CONTAIN; ADAPTED BAGS AND COVER-
INGS FOR TENNIS, BADMINTON AND SQUASH
RACKETS, FOR TABLE TENNIS AND CRICKET
BATS, FOR GOLF CLUBS AND FOR HOCKEY
STICKS; ROLLER SKATES, ICE SKATES AND IN-
LINE SKATES, TABLES AND NETS FOR TABLE
TENNIS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

PRIORITY DATE OF 9-30-2006 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION
0925647 DATED 2-2-2007, EXPIRES 2-2-2017.

SER. NO. 79-039,078, FILED 2-2-2007.

KIMBERLY FRYE, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 890,009

United States Patent and Trademark Office

Registered Apr. 28, 1970

Amended

OG Date Aug. 24, 2010

TRADEMARK
PRINCIPAL REGISTER



PUMA AG RUDOLF DASSLER SPORT
(FED REP GERMANY CORPORATION)
WUERZBURGER STR. 13
HERZOGENAURACH, FED REP GER-
MANY

FOR: SPORT SHOES—NAMESLY, SOC-
CER SHOES, [LACROSSE SHOES,]
BOWLING SHOES, BOXING SHOES,
GYMNASTIC SHOES,] JOGGING SHOES,

WRESTLING SHOES, FENCING SHOES,
TRACK SHOES, CROSS COUNTRY
SHOES; [AND FOOTBALL SHOES]
SPORTING SHOES—NAMESLY, BASKET-
BALL SHOES, TENNIS SHOES, AND
BOATING SHOES, IN CLASS 25 (INT.
CL. 25).

FIRST USE 0-0-1958; IN COMMERCE
0-0-1958.

SER. NO. 72-288,345, FILED 1-8-1968.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Aug. 24, 2010.*

EXHIBIT C

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

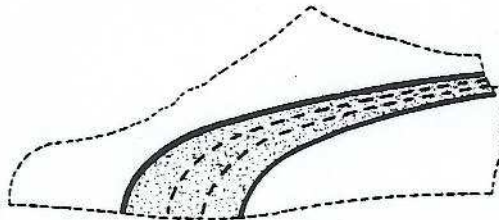
United States Patent and Trademark Office

Reg. No. 1,256,945

Registered Nov. 8, 1983

TRADEMARK

Principal Register



Puma-Sportschuhfabriken Rudolf Dassler KG (Fed.
Rep. of Germany limited partnership)
Herzogenaurach, Fed. Rep. of Germany

For: SHOES, ESPECIALLY SPORTS AND
LEISURE SHOES, in CLASS 25 (U.S. Cls. 22 and
39).

Owner of Fed. Rep. of Germany Reg. No.
944,093, dated May 4, 1976, expires Nov. 4, 1985.

Owner of U.S. Reg. Nos. 890,009 and 1,135,790.

The stippling shown on the drawing is for the
purpose of dividing the stitching part of the mark into
three sections.

Sec. 2(f).

Ser. No. 279,936, filed Sep. 30, 1980.

J. H. WEBB, Examining Attorney

EXHIBIT D

Int. Cl.: 25

U.S. Cl.: 39

Reg. No. 1,135,790

U.S. Patent and Trademark Office

Registered May 20, 1980

TRADEMARK

Principal Register



Puma-Sportschuhfabriken Rudolf Dassler KG (Fed. Rep. of
Germany limited partnership)
P.O. Box 1420
D-8522 Herzogenaurach, near Nurnberg, Fed. Rep. of Ger-
many

For: SHOES, PARTICULARLY SPORT AND LEI-
SURE SHOES, in CLASS 25 (U.S. CL. 39).
First use 1958; in commerce 1958.

Ser. No. 144,331. Filed Oct. 11, 1977.

PAUL F. GAST, Primary Examiner

EXHIBIT E

PUMA'S SHOES

